

Application No. 09/980,593

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REMARKSI. Status of the application

Claims 1-6 and 8 are pending. Claims 1-6 have been allowed, and claim 8 has been rejection. In this response, claim 8 has been amended. Support for the amendment to claim 1 may be found on page 1, lines 6-18. Amendments made herein have been made to expedite prosecution.

II. Rejection of claim 8 under 35 U.S.C. § 112, first paragraph

The examiner has rejected claim 8 under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement. The examiner states that claim 8 recites a method of treating metalloproteinase mediated disease in general, but that the specification is not enabled for such a scope. The examiner notes that in the specification on page 1, there are about 17 MMP's associated with many disease conditions, but that the applicants are claiming the treatment to all metalloproteinase mediated disease. See page 2 of the official action. On page 13 of the official action, the examiner states that the applicants can overcome the rejection by limiting the MMP and by reciting specific diseases that are tied with said MMP.

Per the examiner's suggestion, the applicants have amended claim 8 to recite the specific MMPs listed on page 1 of the specification. Accordingly, the applicants submit that this claim is now enabled, and request that the examiner withdraw the rejection of claim 8 under 35 U.S.C. § 112, first paragraph.

III. Rejection of claim 8 under 35 U.S.C. § 112, second paragraph

The examiner has rejected claim 8 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner states that the scope of claim 8 is unknown and that there is no standard list of diseases. The examiner then set forth a series of questions to demonstrate how, according to the examiner, the claims are indefinite.

As stated above, the applicants have amended claim 8 to recite the specific MMPs listed on page 1 of the specification. As amended, claim 8 more clearly and more definitively recites the claimed invention. None of the terms recited in claim 8 would render the claim unclear or indefinite to a skilled artisan. Accordingly, claim 8 is definitive and the applicants

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respectfully request that the examiner withdraw the rejection under 35 U.S.C. § 112, second paragraph.

Additionally, the applicants note that claim 8 has been amended to depend on claim 1, which the examiner has allowed. Since the compound of claim 1 is recognized by the examiner as enabled and definite, within the meaning of 35 U.S.C. § 112, a method of using the compound of claim to treat specific diseases, such as claim 8, should also be considered enabled and definite. After all, the scope of dependent claim 8 is, by definition, narrower than the scope of claim 1, the claim for which it depends.

IV. Conclusion

The applicants believe that the application is in condition for allowance and respectfully request early notification to that effect.

Should any issues remain unresolved, the examiner is encouraged to contact the undersigned attorney for the applicants at the telephone number indicated below in order to expeditiously resolve any remaining issues.

Respectfully submitted,

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